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10/772,889	02/04/2004	Dean J. Richtsmeier	200313857-1	5369
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EXAMINER KAPLAN, HAL IRA				
ART UNIT 2836		PAPER NUMBER		
NOTIFICATION DATE 10/01/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

JERRY.SHORMA@HP.COM

ipa.mail@hp.com

jessica.l.fusek@hp.com

Office Action Summary

Application No.

10/772,889

Applicant(s)

RICHTSMEIER ET AL.

Examiner

HAL I. KAPLAN

Art Unit

2836

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 and 38-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 19, 20, 22, 23, 25-27, 31-33 and 36-40 is/are rejected.
- 7) ☒ Claim(s) 17, 18, 21, 24, 28-30, 34, 35, 41 and 42 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 December 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-918)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The Examiner wishes to thank the Applicant for the time and courtesies extended in the telephone interview on July 30, 2009.

1. In view of the Appeal Brief filed on June 12, 2009, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Jared J. Fureman/

Supervisory Patent Examiner, Art Unit 2836

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, 5-8, 14-16, 20, 22-23, 25-27, 31, and 40 are rejected under 35 U.S.C. 102(e) as being anticipated by the US patent of Chu (6,774,509).

As to claim 1, Chu discloses an electronic device comprising a face (12B); a switch (110B) configured such that successive actuations of the switch (110B) actuates the device between a first state (low range speed) and a second state (full range speed); and a switch actuation mechanism (12B-1, 12B-2, 146B) configured to actuate against a point of contact (141B) of the switch a first time in response to a first manual input (on region 12B-1) along the face to actuate the device to the first state (on) and to actuate against the same point of contact (141B) of the switch a second time in response to a second manual input along the face (on region 12B-2) to actuate the device to the second state (full range speed), wherein the second input has at least one characteristic (e.g. location, whether one or two of variable resistors 120B are operating), other than time at which it is performed, distinct from the first input (see column 8, line 25 - column 9, line 18 and Figure 10).

As to claim 2, a function is performed when the device of Chu is in a first state (low range speed) and discontinued when the device is in a second state (full range speed) (see column 8, line 62 - column 9, line 18).

As to claim 5, the switch actuation mechanism (12B-1,12B-2) of Chu includes a first movable surface (12B-1) and a second movable surface (12B-2) and the first input includes moving the first movable surface and the second input includes moving the second movable surface (see column 8, line 62 - column 9, line 18 and Figure 10).

As to claims 6 and 7, the first and second movable surfaces of Chu are depressible (see column 8, lines 62-67 and column 9, lines 7-12).

As to claim 8, the first surface and the second surface of Chu are spaced from one another along the face (see Figure 10).

As to claims 14 and 16, the actuation mechanism (12B-1,12B-2,146B) of Chu includes a first button (12B-1) providing the first surface; a second button (12B-2) providing the second surface; and an extension (142) coupled to (engaged with) the first and second buttons (12B-1,12B-2) and linearly movable relative to the switch and the first button (12B-1) (see column 5, lines 39-49; column 8, lines 25-35 and 49-61; and Figures 2 and 10).

As to claim 15, Chu discloses a guide (145) guiding linear movement of the extension (142) relative to the switch (110B) (see column 5, lines 39-49).

As to claims 20, 23, and 31, the first and second inputs (depression of 12B-1 or 12B-2) of Chu are parallel to each other (see Figure 10).

As to claim 22, Chu discloses an electronic device comprising: a face (12B); a switch (110B) configured such that successive actuations of the switch (110B) that are identical other than time at which they are performed, actuate the device between a first state (off) and a second state (on); and means (12B-1, 12B-2, 146B) along the face (12B) for actuating the switch a first time using a first manual input and a second time using a second manual input having at least one characteristic (e.g. location, whether one or two of variable resistors 120B are operating), other than time at which it is performed, distinct from the first manual input (see column 8, line 25 - column 9, line 18 and Figure 10).

As to claim 25, Chu discloses a method for actuating an electronic device between a first state and a second state, the method comprising: providing a switch (110B) configured such that successive actuations of the switch that are identical other than time at which they are performed, actuate the device between a first state (off) and a second state (on); applying a first manual input (via 12B-1), along a substantially planar face (12B) of the device so as to actuate the switch a first time; and applying a second manual input (via 12B-2) along the substantially planar face (12B) of the device so as to actuate the switch a second time, wherein the second manual input has at least one characteristic (e.g. location, whether one or two of variable resistors 120B are operating), other than the time at which it is performed, that is distinct from the first manual input (see column 8, line 25 - column 9, line 18 and Figure 10).

As to claims 26 and 27, Chu discloses the step of applying an input including depressing an actuation member (141B,144) operably coupled to the switch (see column 5, lines 43-49 and Figure 2).

As to claim 40, Chu discloses a resilient depressible actuator (141B,142-145), wherein a same portion of the actuator is depressed in response to both the first input and the second input (see column 4, lines 23-26 and 35-48; column 5, lines 39-49; and Figure 2).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 3, 4, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chu in view of the US patent of Downing et al. (6,075,925).

As to claim 3, Chu discloses all of the claimed features, as set forth above, except for the claimed print medium. Downing, drawn to a control panel for image forming devices, discloses an image forming device wherein printing upon a print medium is performed when the device is in a first state and discontinued when the device is in a second state (see column 3, lines 32-36 and column 5, lines 20-24). It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have used the switching device of Chu to the image forming device of Downing on and off, because the switching device of Chu can be used with any electrical appliance. In addition, the recitation of claim 3 is an intended use recitation, and it has been held that an intended use recitation does not create a patentable distinction. *Ryco, Inc. v. Ag-Bag Corp.*, 857 F.2d 1418, 8 USPQ2d 1323 (Fed. Cir. 1988). See MPEP §2144.07.

As to claim 4, the switch actuation mechanism (12B-1,12B-2) of Chu includes a first movable surface (12B-1) and a second movable surface (12B-2) and the first input includes moving the first movable surface and the second input includes moving the second movable surface (see column 8, line 62 - column 9, line 18).

As to claim 19, neither Chu nor Downing specifically disclose an imaging material dispensing device. However, Downing discloses a laser printer (100), and it is inherent that a laser printer comprises an imaging material dispensing device (toner cartridge). Downing also discloses a controller (20) coupled to a switch (15), wherein the dispensing device dispenses imaging material and discontinues dispensing imaging material in response to the control signals (see column 5, lines 42-45).

8. Claims 9-13 rejected under 35 U.S.C. 103(a) as being unpatentable over Chu in view of the US patent of Parks et al. (5,877,746).

As to claim 9, Chu discloses all of the claimed features, as set forth above, except for the claimed first and second indicia. Parks discloses two switches (22,23) comprising first and second movable surfaces, wherein the first movable surface (22) has a first indicia (green color) and wherein the second movable surface has a second indicia (red color) distinct from the first indicia (green color) (see column 13, lines 6-18 and Figure 3). It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified Chu by using green and red colors for the first and second movable surfaces (12B-1,12B-2), so that a novice user can determine which button to press to perform a given function (see Parks, column 13, lines 15-18).

As to claims 10 and 12, the first and second indicia have distinct colors (green and red) (see column 13, lines 6-11).

As to claim 11, the first indicia includes a first color (green) and the second indicia includes a second color (red) distinct from the first color (green) (see column 13, lines 6-11).

As to claim 13, the device of Chu performs a function (full motor speed) upon movement of the first surface (12B-1) and discontinues the function (discontinues full motor speed by running at lower speed) upon movement of the second surface (12B-2).

9. Claims 32-33, 36, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chu in view of the US patent of Mori et al. (6,337,961).

As to claims 32-33, 36, and 38, Chu discloses all of the claimed features, as set forth above, except for an image forming engine. Chu discloses a post (142) operably coupled to the switch to apply an actuating force to the switch, wherein the movement of the input surface (141) linearly moves the post (142) along an axis against the switch to actuate the switch to the first state or the second state (see column 5, lines 39-49 and Figure 2). Mori, drawn to a print control method and apparatus, and printer, discloses an image forming engine (17) actuatable between a first state and a second state (see column 4, lines 49-56). It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have used the switch of Chu in a printer with an image forming engine, because it would be easier for the user to determine that the switch has been toggled and the device is working properly.

10. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chu in view of Mori, as applied to claim 32 above, and further in view of Parks.

As to claim 39, Chu in view of Mori disclose all of the claimed features, as set forth above, except for the distinct associated indicia. Parks discloses two switches (22,23) comprising first and second movable input surfaces, wherein the first and second movable input surfaces have distinct associated indicia (green and red colors)

(see column 13, lines 6-18 and Figure 3). It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified Chu in view of Mori by using green and red colors for the first and second movable surfaces (12B-1, 12B-2), so that a novice user can determine which button to press to perform a given function (see Parks, column 13, lines 15-18).

Allowable Subject Matter

11. Claims 17-18, 21, 24, 28-30, 34-35, 41, and 42 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. The following is a statement of reasons for the indication of allowable subject matter:

Claims 17, 29, and 41 contain allowable subject matter because none of the prior art of record discloses or suggests the switch actuation mechanism including an actuation member slidable along the face, wherein the first input includes sliding the actuation member in a first manner and wherein the second input includes sliding the actuation member in a second manner, in combination with the remaining claimed features.

Claims 18 and 30 contain allowable subject matter because none of the prior art of record discloses or suggests the actuation mechanism including an actuation member pivotally supported along the face, wherein the first input includes pivoting the actuation member in a first manner and wherein the second input includes pivoting the

actuation member in a second manner, in combination with the remaining claimed features.

Claims 21 and 24 contain allowable subject matter because none of the prior art of record discloses or suggests the switch actuation mechanism or means for actuating being configured to also actuate the switch the second time in response to a third input identical to the first input, other the time at which it is performed and in lieu of the second input, in combination with the remaining claimed features.

Claim 28 contains allowable subject matter because none of the prior art of record discloses or suggests the step of applying a first input including moving an actuation member in a first manner and the step of applying a second input including moving the actuation member in a second distinct manner, in combination with the remaining claimed features.

Claim 34 contains allowable subject matter because none of the prior art of record discloses or suggests the first and second movable input surfaces pivoting to successively actuate the switch, in combination with the remaining claimed features.

Claim 35 contains allowable subject matter because none of the prior art of record discloses or suggests the first movable input surface and the second movable input surface sliding along a substantially common plane to successively actuate the switch, in combination with the remaining claimed features.

Claim 42 contains allowable subject matter because none of the prior art of record discloses or suggests the switch being configured such that identical successive

actuators of the switch actuates the device between the first state and the second state, in combination with the remaining claimed features.

Response to Arguments

13. After further review of the claims and the Applicant's arguments submitted in the Appeal Brief dated June 12, 2009, the Office finds that Chu is anticipatory with respect to claims 1, 2, 5-8, 14-16, 20, 22-23, 25-27, 31, and 40, as set forth above.

14. Applicant's arguments with respect to claims 1-36 and 38-42 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HAL I. KAPLAN whose telephone number is (571)272-8587. The examiner can normally be reached on M-F 9:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jared Fureman can be reached on 571-272-2391. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jared J. Fureman/
Supervisory Patent Examiner, Art
Unit 2836

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09/17/2009